

**Amendments to the Drawings:**

The attached Replacement sheets of drawings including Figs. 1-6e are formal drawings which replace the original sheets containing Figs. 1-6e. Approval and entry are respectfully requested.

Attachment: thirteen (13) Replacement sheets

## **REMARKS**

### **I. Introduction**

With the addition of claims 139 to 144 and the cancellation herein without prejudice of claims 70 to 87 and 95 to 138, claims 88 to 94 and 139 to 144 are currently pending in the present application, since claims 1 to 69 were previously canceled. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested. No new matter has been added.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statements, 1449 papers, and cited references.

### **II. Objection to the Drawings**

Formal Drawings are submitted herewith as requested by the Examiner.

### **III. Rejection of Claims 87 to 94 Under 35 U.S.C. § 112, ¶ 2**

Claims 87 to 94 stand rejected under 35 U.S.C. § 112, ¶ 2 as assertedly indefinite.

With respect to now canceled claim 87, the subject matter of which has been incorporated in each of claims 89 and 91, the Office Action asserts that the term “task” is unclear. The term task is to be understood in its ordinary sense as a labor or job. There is nothing unclear about the term. Accordingly, no amendment is necessary.

The Office Action further asserts that the term “element group system” is unclear. While Applicants do not agree, to facilitate matters, the claims have been amended herein without prejudice to refer instead to an “element group,” which is to be understood according to its ordinary meaning as a group of elements.

The Office Action further asserts that claim 87, the features of which are now included in claims 89 and 91, omits an essential step, since the claim does not indicate on what basis the determination of the suitability of element groups is made. Similarly, the Office Action asserts that claim 94 omits an essential step, since the claim does not indicate how the interconnection allows for a transmission of data from cell to cell in a manner at least largely free of delay.

As an initial matter, with respect to the feature of determining a plurality of element groups that are suitable for performing a task, the basis on which the determination is made would further define the already recited step of “determining”; it would not be an

additional step. Thus, claims 89 and 91 do not omit any step with regard to the determination of suitability. Similarly, with respect to the feature of “the determined interconnection allows for a transmission . . . at least largely free of delay,” the feature provides an additional limitation on the recited step of “determining . . . interconnections of cells of the element group.” How the determined interconnection allows for such a transmission would more narrowly define the step of “determining . . . interconnections”; it would not be an additional step.

Moreover, while “[a] claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected,” M.P.E.P. § 2172.01, none of the claims omit a step indicated in the specification or other statements of record as being essential to practice the method. Specifically, the specification does not indicate that any particular method of determining suitability is essential, and does not indicate that any particular sub-step is essential in the determination of the interconnection.

Moreover, claims recite the invention. Their purpose is not to explain how the invention works. Thus, the claims need not at all recite how a claimed method works. That role is left to the specification. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558 (Fed. Cir. 1983). Thus, the claims need not explain how such a suitability determination might be performed or how the determination of the interconnection that results in transmissions at least largely free of delay might be performed.

To the extent the rejection is based on the Examiner’s belief that the claims are overbroad because they may read on multiple ways of determining the suitability or the interconnection, it is noted that the breadth of a claim is an inappropriate basis for a rejection of the claim. As § 2173.04 of the M.P.E.P., entitled “Breadth Is Not Indefiniteness,” states: “Breadth of a claim is not to be equated with indefiniteness.” See also *In re Miller*, 169 USPQ 597 (CCPA 1971). Regardless of breadth, if the scope of the subject matter embraced by the claims is clear, and “[i]f applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.” M.P.E.P. § 2173.04. A claim therefore can both be broad and, at the same time, clearly demarcate to those of ordinary skill in the art the boundaries of Applicants’ invention. In order to establish that these claims are too broad, that is, that the scope of invention to which Applicants are striving to attain, e.g., without more particularly reciting how the suitability determination is performed, is more than what they are entitled to under the Patent Act, specific evidence in the form of references or other

publications must be brought forth by the Patent Office. Therefore, the issue of breadth is one that pertains not to the understandability of the claims, since claims that are broad are not inherently indefinite, but to the outer limits of what Applicants are entitled to exclude others from making, using, or selling, limits which are bounded by what is in the public domain and also by what others have already staked out for themselves as their own property. In other words, the proper rubrics for examining the issue of breadth are those of anticipation and obviousness under §§ 102 and 103. Thus, even if the claims are broad in scope, claims 89 and 94 are, nevertheless, clear, give no rise to ambiguity, and are therefore definite.

With respect to claim 88, the Office Action asserts that the term “likely” renders the claim indefinite because the claim thereby includes elements not actually disclosed – those encompassed by “or the like.” Applicants respectfully traverse this assertion. The word “likely” does not have the same meaning as “or the like” and does not function to include further elements. While “or the like” means either the recited element or other elements, “likely” means having a high chance of being the case. Therefore, the term does not cause the claim to encompass elements not actually disclosed. Instead, the claim means that there has been a determination that the chance of the case being that the elements will be soon available is high.

Accordingly, all of the claims are clear, give rise to no ambiguity, and are therefore definite. Withdrawal of this indefiniteness rejection is therefore respectfully requested.

#### **IV. Allowable Subject Matter**

Applicants thank the Examiner for indicating that claims 89 to 91 are allowable. In this regard, the Examiner will note that the issues raised under 35 U.S.C. § 112 have been addressed above. The Examiner will also note that each of claims 89 (from which claim 90 depends) and 91 has been rewritten in independent form and to include the subject matter of its base claim. The Examiner will further note that each of claims 88 and 92 to 94 has been amended herein without prejudice to depend from claim 89. Accordingly, all of claims 88 to 94 are in condition for immediate allowance. The remaining rejected claim has been canceled herein without prejudice, thereby rendering moot the remaining claim rejections.

**V. New Claims**

Claims 139 to 144 have been added herein. Claims 139 to 144 do not add new matter and are supported by the application, including specification, as originally presented. Claims 139 to 144 ultimately depend from claim 91, which has been indicated to include allowable subject matter. Accordingly, claims 139 to 144 are allowable for at least the same reasons as claim 91.

**VI. Conclusion**

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Applicants reserve the right to pursue the subject matter of the claims as previously presented in a continuation and/or divisional patent application. Further, any disclaimer that may have occurred during the prosecution of this application is expressly rescinded as regards any subsequently filed patent application.

Respectfully submitted,

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